UNITED STATES PATENT and TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
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In re application of :
Jackson et al. : DECISION ON
Serial No. 10/601,602 : PETITION
Filed: June 23, 2003 :
For: LOW ENERGY CHLORATE ELECTROLYTIC CELL AND PROCESS

This is a decision on the PETITION UNDER 37 CFR 1.181 FOR ENTRY OF THE AFTER FINAL AMENDMENT and AFFIDAVIT UNDER RULE 1.132, filed July 3, 2006.

On March 15, 2006, a final office action was mailed to Applicants, rejecting all of the pending claims under 35 USC 102, 35 USC 103, or 35 USC 112. Applicants responded to this office action with an amendment after final and 1.132 affidavit, which was filed on June 5, 2006. The examiner refused entry of the amendment and 1.132 affidavit in an advisory action mailed June 14, 2006.

On July 3, 2006, the instant petition under 37 CFR 1.181 was timely filed to request the entry of the after final amendment and 1.132 affidavit of June 5, 2006.

Petitioner's position is that the amendment after final did not raise any new issues as alleged by the examiner in the advisory action and that the 1.132 affidavit is merely evidence to overcome a baseless presumption by the examiner about what one skilled in the art would know about the properties of Nafion permselective membranes.

DECISION

Section 714.13 of the MPEP states:

ENTRY NOT A MATTER OF RIGHT

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.
Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(c) is expected in all amendments after final rejection. Failure to properly reply under 37 CFR 1.113 to the final rejection results in abandonment.

An amendment filed at any time after final rejection, but before an appeal brief is filed, may be entered upon or after filing of an appeal brief provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt examiner suggestions.

ACTION BY EXAMINER
See also MPEP § 706.07(f).
In the event that the proposed amendment does not place the case in better form for appeal, nor in condition for allowance, applicant should be promptly informed of this fact, whenever possible, within the statutory period. The refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified. Ordinarily, the specific deficiencies of the amendment need not be discussed. The reasons for nonentry should be concisely expressed. For example:

(A) The claims, if amended as proposed, would not avoid any of the rejections set forth in the last Office action, and thus the amendment would not place the case in condition for allowance or in better condition for appeal.
(B) The claims, if amended as proposed, would raise the issue of new matter.
(C) **The claims as amended present new issues requiring further consideration or search.**
(D) Since the amendment presents additional claims without canceling any finally rejected claims it is not considered as placing the application in better condition for appeal. *Ex parte Wirt*, 1905 C.D. 247, 117 O.G. 599 (Comm'r Pat. 1905).

Petitioner argues that the proposed amendment to claims 8 and 34 do not change the scope of the claims, in that the added amendments merely place the claims into Jepson form and places the claims into better form for appeal. This argument is not persuasive. Limitations in the preamble of a Jepson claim do effect scope the claim. The proposed amendments to claims 8 and 34 add the following limitations to the claims which were not previously required: an anode and a cathode in said cell, in the absence of a cell separator, are exposed to the same electrolyte, the anode comprises precious metals deposited on a titanium substrate, and the cathode comprises mild steel or titanium. These newly added limitations to the claims were not earlier presented and thus would require further search and consideration if these amendments to the claims were to be entered.

As to the argument that the affidavit under 37 CFR 1.132, filed June 5, 2006, should have also been entered, this argument is persuasive. According to 37 CFR 1.116:

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

The 1.132 affidavit was submitted by the applicant in order to refute the examiner's rejection to the claims under 35 USC 112, 1st paragraph and in response with the examiner's suggestion for evidential data, in the final rejection of March 15, 2006. In the final office action of March 15, 2006, the examiner made the statement inviting data indicating properties of the prior art membranes. It appears that this 1.132 affidavit is in direct response to said invitation by the examiner and thus should have been considered by the examiner.

Accordingly, this petition for entry of the after final amendment and 1.132 affidavit is **GRANTED-IN-PART**.

Specifically, the request for entry of the amendment after final has been denied and the request for entry of the 1.132 affidavit after final has been granted.

Therefore, the application will be forwarded to the examiner for prompt consideration of the 1.132 affidavit.

The statutory period for response continues to run from the July 3, 2006 date of the Notice of Appeal.

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